

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUGH E. FARGHER and RICHARD A. SMITH

Appeal No. 1998-3416
Application 08/096,538

HEARD: MARCH 6, 2001

Before THOMAS, BARRETT, and LEVY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 12, which constitute all the claims in the application.

Representative claim 1 is reproduced below:

1. An apparatus for generating a plan, comprising:

circuitry for reading a list of priorities including both planner goals and scheduling goals and a goals list including goals indicating either a planner goal or a schedule goal comprising;

circuitry for producing a global production strategy list from said priorities list and said goals list; and

circuitry for resolving a choice from said goals list.

The following reference is relied on by the examiner:

Litt et al. (Litt)	5,148,370	Sept. 15, 1992
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Claims 1 through 12 stand rejected under the first paragraph of 35 U.S.C. § 112 as being based upon an inadequate disclosure. These claims also stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Litt alone.

Rather than repeat the positions of the appellants and the examiner, reference is made to the briefs and the answer for the respective details thereof.

OPINION

We reverse both rejections.

Turning first to the rejection of the claims under the first paragraph of 35 U.S.C. § 112, the specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation. Genentech, Inc. v. Novo

Nordisk A/S, 108 F.3d 1361, 1365, 42 USPQ2d 1001, 1004 (Fed. Cir.), cert. denied, 118 S.Ct. 397 (1997). This same case indicates that the scope of the claims must bear a

reasonable correlation to the scope of enablement provided by the disclosure.

Enablement is also not precluded even if some experimentation is necessary, although the amount of experimentation needed must not be unduly excessive. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

If the examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the appellants to come forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232-33 (CCPA 1973), cert. denied, 416 U.S. 925 (1974); In re Brown, 477 F.2d 946, 950, 177 USPQ 691, 694 (CCPA 1973); and In re Ghiron, 442 F.2d 985, 992, 169 USPQ 723, 728 (CCPA 1971). However, the burden was initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976); and In re Armbruster, 512 F.2d 676, 678, 185 USPQ 152, 154 (CCPA 1975).

Although we sympathize somewhat with the examiner's views expressed in the answer as to this rejection, the subject matter of each independent claim on appeal basically reflects in like manner and scope the data structures set forth in Figures 3 through

6 and the operation of the overall planning and scheduling system set forth in Figure 7, and not the broadly defined block diagram structures labeled in Figures 1 and 2. The claimed list of priorities is depicted in Figure 6 and the goals list of the claims is reflected in Figure 4. Both of these are utilized to produce the global production strategy of the claims as disclosed in Figure 5. The methodology to resolve choices from the goals list is set forth in the flow chart of Figure 7. Each of the respective lists, tables and strategies set forth in Figures 3 through 6 is discussed broadly beginning at page 9 of the specification to be embodied in the form of data structures in physical memories including RAM, ROM or a disc file system. The discussion at the middle of page 12 of the specification as filed indicates that a computer performs the basic compare and logic operations of Figure 7.

Thus, it is a straight forward matter from an artisan's perspective to view the claimed reading, producing and resolving features of representative independent claim 1 on appeal, for example, as the computer performing these operations in accordance with Figure 7 from data stored in traditional memory elements associated with such a computer system. The claimed circuitry of claim 1, therefore, comprises well-known data storage elements associated with a computer systems also known in the art and broadly taught in the specification as filed. In a corresponding manner, the automated machine implemented method of independent claim 5 has corresponding reading, producing and

resolving steps as are provided for in the circuitry of claim 1. Still further, the means clauses of independent claim 9 also correspond to the circuitry clauses of claim 1 on appeal. The dependent claims also correspond in a similar manner.

In view of the foregoing, we conclude that the examiner has not provided a reasonable basis to question the adequacy of the disclosure as it pertains to the particular subject matter of the claims on appeal. Therefore, the examiner has not made out a prima facie case of non-enablement according to the first paragraph of 35 U.S.C. § 112.

Although it is clear from our study of the specification and drawings as filed that some degree of experimentation would have been necessary for an artisan to make and use the claimed invention based upon the drawings and their associated written description in the specification as filed, we cannot conclude that an undue

amount of experimentation would have been necessary. Therefore, the decision of the

examiner rejecting claims 1 through 12 under the enablement portion of 35 U.S.C.

§ 112 is reversed.

We reach a similar conclusion with respect to the rejection of claims 1 through 12 under 35 U.S.C. § 103. As to the first clause of claim 1, the examiner generally asserts at the bottom of page 4 of the answer that Litt does not specifically address and teach a list of priorities including both planner goals and scheduling goals. At the top of page 5 the

examiner indicates that Litt does not teach the circuitry for producing a global production strategy list, a feature set forth in the second clause of the body of representative claim 1 on appeal. Similarly, the examiner indicates at the bottom of page 5 of the answer that Litt does not explicitly teach a goal list including goals indicating either a planner goal or a scheduler goal, a feature also recited in the first clause of claim 1 on appeal. Finally, the examiner indicates at the top of page 6 of the answer that Litt does not teach a means for resolving a choice from a goals list. This feature is recited at the end of representative claim 1 on appeal.

On the basis of this recognition alone of the examiner in the statement of the rejection of the claims on appeal, we conclude the examiner has not set forth a prima facie case of obviousness. The examiner's attempts with respect to each of the four noted features of claim 1 on appeal as discussed in the previous paragraph of this opinion attempts to argue that the artisan would have found obvious the subject matter anyway based upon the examiner's view of what the reference does teach and what he believes are inherent features of the reference. A reference cannot be said to have an inherent feature if it does not specifically teach or address it in some manner. The examiner's opinion appears to be based upon conjecture and prohibited hindsight. According to the examiner's reasoning presented here, we find it would be very difficult to agree with the examiner's position from the standpoint of having to resolve differences of

the claimed invention with those of the applied prior art when only one reference has been applied as evidence of obviousness. We recognize that Litt does teach certain features of a production scheduling and planning environment, and certain strategies and constraints, but we are left to conjecture on our own whether the artisan would have arrived at the subject matter of representative claim 1 on appeal from what is taught and/or suggested in Litt itself. In order for us to sustain the examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions to supply deficiencies in the factual basis of the rejection. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). This we decline to do. Therefore, we must reverse the rejection of claims 1 through 12 under 35 U.S.C. § 103.

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Since we have reversed the rejection of claims 1 through 12 under the first paragraph of 35 U.S.C. § 112 and a separate rejection of these claims under 35 U.S.C. § 103, the decision of the examiner is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Lee E. Barrett)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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